

REMARKS

The Office Action Summary notes that claims 11-20 are pending. Claims 1-10 were previously canceled with prejudice of or disclaimer to the subject matter contained therein. With entry of the subject amendment, claims 11-12, 14-16, and 19-20 will be pending. Claims 13 and 17-18 are canceled with prejudice of or disclaimer to the subject matter contained therein. Applicants reserve the right to file a divisional or continuation application on any material canceled by way of amendment.

New claim 21 has been added. Applicants have introduced new claim 21 which is drawn to a method for alleviation and treatment of symptoms. This method claim can find descriptive support in the specification at least at page 2, lines 26-32. Additionally, Applicants have amended claims 11, 12, 14-16, 19, and 20 in view of the election of group II. No prohibited new matter has been introduced by entry of the new claims or amendments. The amendments are supported at least by the claims as originally filed as discussed above.

In the Office Action, the Examiner sets forth the restriction requirement as follows:

Group I, “claims 11-19, in part drawn to compounds and composition of formula I’, wherein X is an OH, E is a connecting bond or a methylene group, B is an alkylene, A is a connecting bond, and the group of claims is classified in 546, 514, subclass 192, 317”;

Group II, “claims 11-19, in part, drawn to compounds, pharmaceutical compositions of formula I’ wherein X is an OH, E is an O, B is an alkylene, A is a connecting bond, classified in class 546, 514, subclass 192, 317”;

Group III, “claims 11-19, in part, drawn to compounds, pharmaceutical compositions of formula I’ wherein A is a cycloalkylene and B is a NH-CO(CH₂)_n, classified in class 546, 514, subclass 225, 229, 352, 354”;

Group IV, “claims 11-19, in part, drawn to compounds, pharmaceutical compositions and drawn to other variations not found in Groups I-III”;

Group V, “claim 20, drawn to compounds of formula II”.

Applicants provisionally elect with traverse the claims associated with Group II, i.e., claims 11-19.

Applicants respectfully traverse the restriction requirement as set forth in the Office Action. Applicants respectfully submit that the inventions of at least Groups I, II, III,

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and V should properly be examined together. Under M.P.E.P. § 803, restriction is construed as proper if the subject matter can be restricted into one of two or more claimed inventions, and these inventions are either independent (M.P.E.P. § 806.04) or distinct (M.P.E.P. § 806.05). In fact, 37 C.F.R. § 1.141(a) requires that the inventions be independent and distinct. The second element for a restriction requirement to be proper is that if the search and examination of an entire application can be made without *serious burden*, the Examiner must examine it on the merits, even though it includes claimed independent and distinct inventions. The Office Action does not set forth an explanation of how a search of the claimed invention would be burdensome let alone a serious burden. Accordingly, Applicants assert that a proper restriction under M.P.E.P. § 803 has not been set forth with regard to the originally presented claims, the elections herein therefore are *provisional*. Applicants respectfully request that the restriction be withdrawn or, at the very least, reconsidered.

Applicants provide evidence of why the search is not burdensome for the following reasons. First, the claims of Groups I and II not only belong to the same class, they belong to the same subclass (*i.e.*, class 546 and 514; subclass 192 and 317). Applicants further note that the claims of group III belong to the same class as the claims of Groups I and II. Therefore, search of any of the claims from Groups I, II, and III would be coextensive and thus not burdensome. Furthermore, we note that during the examination of the parent application, now U.S. Patent No. 6,706,734, claim 20, which has been placed into Group V, is included in both Groups I and II. Additionally, Applicants have amended claim 20 to recite that E' is an oxygen atom. With this amendment, claim 20 now falls within the penumbra of the elected Group II. Therefore, claim 20 at least should be rejoined with the claims of provisionally elected Group II.

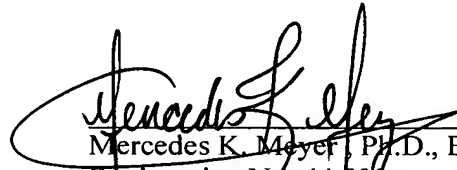
Therefore, Applicants respectfully request rejoinder of the claims for the reasons stated above.

CONCLUSION

In conclusion, this is believed to be in full response to the outstanding restriction requirement. Should any issues remain outstanding or if there are any questions concerning this paper, or the application in general, the Examiner is invited to telephone the undersigned representative at the Examiner's earliest convenience. Should any outstanding fees be owed or overpayments credited, the Commissioner is invited to respectively charge or credit Deposit Account No. 50-0573.

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Respectfully submitted,


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